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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,418	11/24/2003	Ray Skaggs	SKA839.0001	5111
34487	7590	08/09/2006	EXAMINER	
BRENT A. CAPEHART LaRiviere, Grubman & Payne, LLP 19 Upper Ragsdale Drive, Suite 200 P.O Box 3140 Monterey, CA 93940			WARTALOWICZ, PAUL A	
		ART UNIT	PAPER NUMBER	
		1754		
DATE MAILED: 08/09/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/720,418	SKAGGS, RAY	
	Examiner Paul A. Wartalowicz	Art Unit 1754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 June 2006.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,3,4,6,7,10,12,13 and 15-22 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,3,4,6,7,10,12,13 and 15-22 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 11/24/03 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed on June 28, 2006 have been fully considered but they are not persuasive.

Applicant argues that Mezzanotte is not analogous or reasonably pertinent to the problem set out in the present application, applicant states that to be analogous, it must logically commend itself to the attention of the inventor and that in this case a reference that teaches making a rubber or like material stiff and non-flexible would not be one that an inventor of a flexible insert, such as the present invention or the Rylander device, would consider.

This argument is not persuasive for the following reason: The Mezzanotte patent has the broad teaching wherein it is well known that one or more metal cords can be imbedded in a polymer to strengthen and add rigidity as taught by Mezzanotte et al. (col. 3, lines 7-15) such that the patent is drawn to illustrating that metal rods can be imbedded in a polymer structure to add strength and rigidity. This is a broad teaching that can be applied across a wide spectrum of art to which it is of use. This teaching of motivation to embed a metal rod in a polymer to add rigidity is thus applicable in this case because Rylander teaches a polymer panel and Steinmetz teaches a metal rod used for embedding. The motivation to combine stems from Mezzanotte such that the broad teaching is applicable to the combination of Rylander and Steinmetz. It is submitted that the teaching in Mezzanotte would lend itself as a motivation to the

combination of Rylander and Steinmetz and would thusly provide an appropriate teaching in the 35 USC 103 rejections.

Applicant argues that to be analogous, the teaching (of Mezzanotte) must be logically related to and reasonably pertinent to the problem set out in the present application, i.e. creating a flexible panel.

This argument is not persuasive for the following reason: The Mezzanotte patent has the broad teaching wherein it is well known that one or more metal cords can be imbedded in a polymer to strengthen and add rigidity as taught by Mezzanotte et al. (col. 3, lines 7-15) such that the patent is drawn to illustrating that metal rods can be imbedded in a polymer structure to add strength and rigidity. This is a broad teaching that can be applied across a wide spectrum of art to which it is of use. This teaching of motivation to embed a metal rod in a polymer to add rigidity is thus applicable in this case because Rylander teaches a polymer panel and Steinmetz teaches a metal rod used for embedding. The motivation to combine stems from Mezzanotte such that the broad teaching is applicable to the combination of Rylander and Steinmetz. It is submitted that the teaching in Mezzanotte would lend itself as a motivation to the combination of Rylander and Steinmetz and would thusly provide an appropriate teaching in the 35 USC 103 rejections. The problem set out in the present application is thusly interpreted as creating a flexible panel with metal reinforcements.

Applicant argues that Steinmetz discloses that the greater the stiffness, the less flexible his device and that stiffness is not a characteristic wanted or desired in either Rylander or Steinmetz and that Mezzanotte is non-analogous for the reason that Mezzanotte teaches how to stiffen and reduce flexibility to rubber or similar material.

This argument is not persuasive for the following reason: The Mezzanotte patent has the broad teaching wherein it is well known that one or more metal cords can be imbedded in a polymer to strengthen and add rigidity as taught by Mezzanotte et al. (col. 3, lines 7-15) such that the patent is drawn to illustrating that metal rods can be imbedded in a polymer structure to add strength and rigidity. Mezzanotte is not relied upon to teach flexibility, only how to impart strength and rigidity. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Mezzanotte is not relied upon to teach stiffness, but strength and reinforcement of a polymer material with metal chords.

Applicant argues that Steinmetz teaches the insertion of a rod into either the hem of a bag or through the bag itself and that this device thus just merely keeps open the opening portion of the bag requiring the user to hold the bag up when filling its interior, whereas the Rylander device can be a stand-alone device.

This argument is not persuasive for the following reason: Steinmetz is relied upon to teach that a metal rod is used in the art of holding a trash bag open (col. 1, lines 55-59). Steinmetz is not relied upon to teach the metal rod being inserted into the plastic panel. The motivation for the insertion of the metal rod into the plastic panel of Rylander stems from Mezzanotte. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). As to the argument that that this (Steinmetz) device thus just merely keeps the open the opening portion of the bag requiring the user to hold the bag up when filling its interior, whereas the Rylander device can be a stand-alone device, whether the invention of Steinmetz is stand-alone is not of issue in the present application because 1) the feature is not claimed: In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a stand-alone quality of the inserted bag holder) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993) and 2) the combination of the references must be viewed as a whole: In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA

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1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Both Steinmetz and Rylander patents are directed to the art of holding a bag open, and is some evidence that Steinmetz and Rylander are analogous art.

Applicant argues that as set in the '011 Patent, polycarbonate material having a thickness of 0.060 inch and that the flexible material has sufficient memory characteristics such that the body will open back into its initial flat configuration upon being removed from the bag and that Rylander does not teach any sort of penetrate into any part of the flexible bag, or tear or rip into the bag.

This argument is not persuasive for the following reason: Steinmetz is not relied upon to teach the plastic panel of Rylander to be imbedded into the plastic bag of which is to be held open. In response to applicant's argument that Rylander does not teach any sort of penetrate into any part of the flexible bag, or tear or rip into the bag, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). As to the argument that Rylander has sufficient memory characteristics, it is submitted that the combination of Rylander, Steinmetz, and Mezzanotte is an improvement upon the Rylander patent in substantially the same way that the current application is. The result of this combination is a flexible panel with reinforcing rods for added strength and rigidity.

Applicant argues that the Applicant sets forth the factual basis for Mr. Rylander's position that he, as one skilled in the art, would not consider combining either Steinmetz or Mezzanotte with his patent and that these statements should be sufficient evidence to demonstrate the present invention as claimed to be non-obvious. MPEP 716.01 and *In re Oelrich*, 198 USPQ 210.

This argument is not persuasive for the following reason: The statements of the affidavit as a matter of evidence are considered. The affidavit is in the form of a reasoned explanation as to why the rejection should not be maintained, the response to which is below.

The affidavit states that the invention of the '011 patent has sufficient memory characteristics such that the body will open back into its initial flat configuration upon being removed from the bag nor does the invention penetrate into any part of the flexible bag, nor tear or rip into the bag.

Steinmetz is not relied upon to teach the plastic panel of Rylander to be imbedded into the plastic bag of which is to be held open. In response to applicant's argument that Rylander does not teach any sort of penetrate into any part of the flexible bag, or tear or rip into the bag, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). As to the argument that Rylander has sufficient memory characteristics, it is submitted that the combination of

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Rylander, Steinmetz, and Mezzanotte is an improvement upon Rylander alone in the same way that the current application is. The result of which is a flexible panel with reinforcing rods for added strength and rigidity.

The affidavit states that the Steinmetz rod, which has a thickness of at least 3/16 inches is not compatible with the '011 flexible panel because the material has a thickness of 0.060 inches.

In the combination of Steinmetz and Rylander, the concept of the Steinmetz rod is combined with the flexible panel of Rylander. The adaptation of the Steinmetz rod to a smaller thickness is an obvious result of the combination of Rylander with Steinmetz and Mezzanotte.

The affidavit states that the Rylander device is a flat body that is inserted into the interior of a bag and that Steinmetz's device is a thick rod, having either a pointed end or square end for penetrating either the hem of the bag or the bag itself.

The rejection relies upon Steinmetz to teach a resilient rod made from metal (col. 1, lines 52-55; col. 1, lines 63-64) that is imbedded in a trash bag (fig. 1, #21,28) for the purpose of stretching the bag open such that an arm load of trash may be placed within the circle (col. 1, lines 55-59). The rod of Steinmetz is used for embedding into the panel of Rylander as motivated by Mezzanotte.

The affidavit states that Mezzanotte is not prior art and is not relevant to the panel of Rylaner as evidenced that the Mezzanotte radial tire patent is not related to trash, grass, lawn clippings, leaves, debris or other waste products.

The Mezzanotte patent has the broad teaching wherein it is well known that one or more metal cords can be imbedded in a polymer to strengthen and add rigidity as taught by Mezzanotte et al. (col. 3, lines 7-15) such that the patent is drawn to illustrating that metal rods can be imbedded in a polymer structure to add strength and rigidity. Mezzanotte is not relied upon to teach flexibility, only how to impart strength and rigidity. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

This is a broad teaching that can be applied across a wide spectrum of art to which it is of use. This teaching of motivation to embed a metal rod in a polymer to add rigidity is thus applicable in this case because Rylander teaches a polymer panel and Steinmetz teaches a metal rod used for embedding. The motivation to combine stems from Mezzanotte such that the broad teaching is applicable to the combination of Rylander and Steinmetz. It is submitted that the teaching in Mezzanotte would lend itself as a motivation to the combination of Rylander and Steinmetz and would thusly provide an appropriate teaching in the 35 USC 103 rejections.

The affidavit states that the combination of Rylander with Steinmetz and Mezzanotte would result in a body having a thickness significantly greater than that set forth in the Rylander patent for the purpose of increasing stiffness and eliminating flexibility.

In response to applicant's argument that the combination of Rylander with Steinmetz and Mezzanotte would result in a body having a thickness significantly greater than that set forth in the Rylander patent for the purpose of increasing stiffness and eliminating flexibility, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

The affidavit states that the Skaggs application does not teach the use of thick rods within its body. Nor does it teach or disclose a device being stiff and without flexibility.

It is submitted the 35 USC 103 rejection over Rylander, Steinmetz, and Mezzanotte teaches a substantially similar invention as that of the Skaggs application such that the qualifications as set forth in 35 USC 103 are satisfied.

The affidavit as a submitted evidentiary document does not provide adequate factual basis for the dissolution of the rejections of record.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 3, 4, 6, 7, 10, 12, 13, and 15-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rylander (U.S. 4749011) in view of Steinmetz (U.S. 5884454) and Mezzanotte et al. (U.S. 3736973).

Rylander teaches a flexible plastic sheeting that has an initial flat configuration and constructed of a suitable material having the chemical and physical properties wherein the sheet may be readily manually deformed to a substantially cylindrical configuration of substantially any desired diameter which will return to its normal flat configuration upon the complete release of external pressures thereon (col. 1, lines 46-58) and a plurality of gripping ridges at the top of the sheet (fig. 7, #42,44). Rylander fails to teach at least one memory retention unit being imbedded in said panel and

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constructed from a second material sufficiently flexible for responding to pressure thereon for deforming into said substantially cylindrical configuration and having sufficient memory characteristics for returning said panel body to its normal flat planar configuration when said pressure has been removed therefrom.

Steinmetz, however, teaches a resilient rod made from metal (col. 1, lines 52-55; col. 1, lines 63-64) that is imbedded in a trash bag (fig. 1, #21,28) for the purpose of stretching the bag open such that an arm load of trash may be placed within the circle (col. 1, lines 55-59). Therefore, it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided the rod (fig. 1, #21,28) of Steinmetz in the plastic sheet (fig. 1, #14) of Rylander because it is well known that one or more metal cords can be imbedded in a polymer to strengthen and add rigidity as taught by Mezzanotte et al. (col. 3, lines 7-15) which provides a material that meets the requirements and purpose of Rylander.

As to claim 4, Rylander teaches that the flat body portion can be constructed from a suitable material having sufficient flexibility for rolling or forming thereof into a substantially cylindrical configuration, a sufficient memory characteristic for resisting taking a "set" in the rolled configuration thereof (col. 3, lines 10-18) but fails to teach the material which the article is constructed from is rubber. However, it would be obvious to one of ordinary skill in the art to use rubber material because rubber meets the material limitations.

As to claims 6, 13, and 15, Steinmetz teaches that the resilient rod can be constructed from a material which tries to straighten out, stretching the bag opening into

a circle that can be made from many materials such as metal or plastic (col. 1, lines 52-55; col. 1, lines 63-64) but fails to teach that the material can comprise specifically spring steel or rubber. However, it would have been obvious to one of ordinary skill in the art to use spring steel or rubber because spring steel and rubber are metals or plastics that meet these limitations.

As to claims 17 and 18, Steinmetz teaches a resilient rod that is embedded in a trash bag and that the rod can comprise many materials such as metal or plastic (col. 1, lines 63-64; col. 2, lines 3-4). It would have been obvious to one of ordinary skill in the art to use rods having either a rectangular cross-section or a circular cross-section because Steinmetz is silent as to any particular cross-section being required and would therefore be open to such readily available rods.

### ***Conclusion***

This is a continuation of applicant's earlier Application No. 10/720418. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Wartalowicz whose telephone number is (571) 272-5957. The examiner can normally be reached on 8:30-6 M-Th and 8:30-5 on Alternate Fridays.

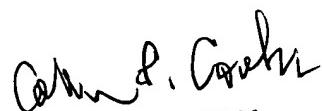
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on (571) 272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Paul Wartalowicz  
August 3, 2006



COLLEEN P. COOKE  
PRIMARY EXAMINER